

for these amendments is found throughout the specification and the drawings, especially pages 25-30 and Figure 6, 7, and 7A. No new matter has been added.

2. Claims 46 and 49-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lomax in view of Goff et. al. The Examiner stated that Lomax essentially teaches all the claimed elements with the exception of an excess adsorbent removal means. The Examiner stated it would have been obvious to modify the Lomax apparatus with a removal means taught by Goff et al. Applicants respectfully traverses the rejections and submits that a prima facie case of obviousness has not been made.

Applicants contend that there is no motivation to combine the teachings of Lomax and Goff et al. Lomax teaches away from an excess solvent removal means, as claimed by the Applicants, by requiring the fabric to be left standing in its wet state. (see Lomax Col. 2 lines 59-64). A prior art must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. See, *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In addition, the proposed modification of Lomax with the excess removal means in Goff et al. would change the principle of operation of Lomax. Lomax teaches a process for obtaining a fabric with a "sheen or luster" which it obtains by stretching fabric that has been left standing in its wet state for about 10 to 12 hours. (See, Lomax Col. 2 lines 55-82) The removal means taught in Goeff et al. requires that a web after submerged in a body of fluid coating it is "then" passed between adjustable squeeze rollers to remove excess coating. (See, Goeff et. al. Col. 5, lines 47-54). If the proposed modification or combination of the prior art would change the principle of operation of the prior art

being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. See, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Finally the modification or combination of Lomax with Goff et al. does not address the problem solved by the Applicant's invention or appreciate its advantages. The Applicants claim a device for preparing a soaked cleaning fabric for use in cleaning a printing press. The Applicants have pointed out throughout the specification problems associated with current technology associated with cleaning a cylinder of a printing press, in particular the problems associated with migration of the cleaning solvent. The Applicant's invention provides very good wettability and distribution of the cleaning solvent in the calendarized fabric, as well as maintenance of the diameter of the supply roll after the calendaring process increases the length of the fabric. This is an important advantage because cleaners are designed to accept fabric rolls of certain diameters. (See, Applicants Specification page 25 lines 15-26 and page 26 lines 1-5) A distinct advantage of the cleaning system of the Applicants invention is that it eliminates the need for complex apparatus to be used on printing machinery that introduce cleansing solvents or solutions to the cleaning fabric prior to use. The Applicants list numerous other advantages in addition. (See, page 31 lines 11-26).

Lomax, on the other hand, teaches an apparatus for finishing or lustering textile fabrics such as satins. (See, Col 1 lines 10-14). Goff et al. teaches a method for smoothing a layer of mobile coating supported on a base sheet. Neither of these references teach or suggest a device for preparing a soaked cleaning fabric for use in cleaning a printing press as the Applicants claim. Thus, the two references combined are neither from the same field of endeavor nor pertinent to the problem to be solved by the Applicants invention.

The Applicants contends that a prima facie case of obviousness has not been made for the above reasons. Reconsideration and withdrawal of the rejections under §103(a) is respectfully requested.

3. Claim 46 was rejected under rejected under 35 U.S.C. §103(a) as being unpatentable over Vecchia in view of Official Notice. The Examiner stated that Vecchia essentially teaches all the claimed elements with the exception of an fabric fluid applying means applying an organic solvent or the calendar reducing thickness and increasing the length of the strip of fabric. Applicants respectfully traverses the rejections and submits that a prima facie case of obviousness has not been made.

Vecchia does not teach or suggest solvent application or the use of calendaring where the calendaring increases the solvent's wettability and distribution in the strip of cleaning fabric. Vecchia does not appreciate the problem solved by the Applicants invention, namely solvent migration in a cleaning fabric used to clean printing presses. Vecchia utilizes calendaring to create a wide variety of appearances on the fabric. (See, Abstract and Col. 4, lines 9-25). The Applicants claim a device having solvent applying and calendaring where the calendaring increases the solvent's wettability and distribution in the strip of cleaning fabric.

It is well settled that a rejection under §103(a) cannot be sustained unless the particular modification is suggested by the prior art itself. There must be something in the prior art as a whole that suggests the desirability, and thus the obviousness of making the modification. See, *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988). The fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. See, *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783

(Fed. Cir. 1992) The teachings of Vecchia does not suggest the claimed device which increases solvent wettability and distribution in the strip of cleaning fabric and in fact teaches away from such a device by not using an organic compound solvent and for using calendaring only for imparting appearances on a fabric.

The Applicants contend that since the cited reference does not teach or suggest what the Applicant claims, a prima facie case of obviousness has not been made. Reconsideration and withdrawal of the rejections under §103(a) is respectfully requested.

4. New claims 51-56 have been added. Support for these new claims is found on page 25, lines 16-20; page 27 lines 13-25; page 29 lines 15-26; and page 30 lines 15-18 and Figures 6, 7 and 7A. No new matter has been added. Claims 51-52 further limit claim 46 and should also be held allowable for reasons previously argued. New claims 53-56 remove the calendaring means from claim 46 and should be held allowable also for reasons previously argued, in particular for reasons related to the Applicant's solutions to problems associated with migration of the cleaning solvent. If non-calendared fabric is used, less solvent stability is obtained, however, the advantages associated with the Applicants device is maintained. (See, page 30 lines 15-18 and page 31 lines 11-26).

### CONCLUSION

Applicants respectfully submit that this application is in form for allowance, and request such an allowance action. If any issues remain, the Examiner is kindly invited to contact the undersigned at the telephone number below. The Examiner's favorable consideration is greatly appreciated.

The Commissioner is hereby authorized to charge any fees which may be required for this amendment, or credit any overpayment, to Deposit Account No. 13-4500, Order No. 0140-4126US1.

In the event that an extension of time is required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 0140-4126US1. A DUPLICATE COPY OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

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**APPENDIX A MARKED UP VERSION OF AMENDED CLAIM**

Please cancel non-elected invention claims 44-45.

Please amend claim 46 as follows:

46. (Three times Amended) A device for [soaking a strip of] preparing a soaked cleaning fabric [on site] for use in cleaning a printing press comprising:

means for mounting a [bulk] first supply roll having [said] a strip of cleaning fabric wound around a shaft;

calendering means for reducing the thickness and increasing the length of said strip of cleaning fabric [on said shaft];

solvent applying means adjacent to said calendering means for applying a low volatility, organic compound solvent which does not readily evaporate at ambient pressure and temperature to said strip of cleaning fabric for forming a soaked strip of cleaning fabric wherein said calendering means increases solvent's wettability and distribution in said strip of cleaning fabric;

means for forming a [cleaning fabric] second supply roll comprising said soaked strip of cleaning fabric, wherein the diameter of [the cleaning fabric] said second supply roll is not substantially increased when [the] said calendering means reduces the thickness and increases the length of [the] said strip of cleaning fabric [on the shaft]; and

an excess solvent removing means interposed between said solvent applying means and said second supply roll for removing excess solvent from said strip of cleaning fabric and obtaining [a] said strip of cleaning fabric saturated to functional equilibrium with said solvent.

51. (New) The device in claim 46, wherein the calendering means further comprises at least a pair of

rollers adjustable in temperature.

52. (New) The device in claim 51, wherein said rollers are heated at a temperature above room temperature.

53. (New) A device for preparing a soaked cleaning fabric for use in cleaning a printing press comprising:

means for mounting a first supply roll having a strip of cleaning fabric wound around a shaft;

solvent applying means for applying a low volatility, organic compound solvent which does not readily evaporate at ambient pressure and temperature to said strip of cleaning fabric for forming a soaked strip of cleaning fabric;

means for forming a second supply roll comprising said soaked strip of cleaning fabric; and

an excess solvent removing means interposed between said solvent applying means and said second supply roll for removing excess solvent from said strip of cleaning fabric and obtaining said strip of cleaning fabric saturated to functional equilibrium with said solvent.

54. (New) The device in claim 53, wherein said solvent applying means further comprises a solvent supply roller and an application roller such that said supply roller is submerged in solvent, and rotation of said solvent supply roller and said application roller causes solvent to transfer from said solvent supply roller to said application roller which then applies solvent to said strip of cleaning fabric.

55. (New) The device in claim 53, wherein said solvent applying means further comprises a rotatably mounted roller submerged in solvent for dipping said strip of cleaning fabric into solvent.

56. (New) The device in claim 53, wherein said solvent applying means further comprises a dipping roller submerged in solvent, and said excess solvent removing means further comprises a squeezing roller juxtaposed to said dipping roller and submerged in solvent.

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